

Appl. No. : 09/608,819  
Filed : June 30, 2000

## REMARKS

The foregoing amendments and the following remarks are responsive to the October 20, 2005 Office Action. Claims 1, 12, and 14 are amended, Claims 3, 4, 7-11, 15-18, 20, 21, and 24-27 remain as previously presented, and Claims 2, 6, 13, 22, and 23 remain as originally filed. Thus Claims 1-4, 6-18, and 20-27 are presented for further consideration. Please enter the amendments and reconsider the claims in view of the following remarks.

### Response to Rejection of Claims 12-15, 16-18, and 20-23 Under 35 U.S.C. § 102(e)

In the October 20, 2005 Office Action, the Examiner rejects Claims 12-15, 16-18, and 20-23 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2002/0056099 by Takahashi et al. ("Takahashi").

#### Claim 12

Applicant has amended Claim 12 to recite (emphasis added):

12. A method of operating a video system that receives video data that includes a plurality of premium contents, the method comprising:  
creating a viewer profile representing viewing preferences of a viewer;  
identifying premium content from the plurality of premium contents consistent with the viewer profile;  
**locally storing the identified premium content;**  
selecting a promotion content associated with the identified, locally stored premium content;  
storing the selected promotion content on a local storage device;  
and  
retrieving the selected promotion content from the local storage device and **displaying the selected promotion content to entice the viewer to select for viewing the identified, previously locally stored premium content.**

In certain embodiments, as described by the present application at page 6, lines 2-12, "premium content with assigned promotional materials" are pre-recorded on a local storage device and promotion contents are displayed "to entice the present viewer to watch one of the pre-recorded premium contents."

Takahashi does not disclose or suggest "locally storing the identified premium content" or "displaying the selected promotion content to entice the viewer to select for viewing the identified, previously locally stored premium content," as recited by amended Claim 12. Takahashi discloses an information processing apparatus and method which stores promotion

**Appl. No.** : **09/608,819**  
**Filed** : **June 30, 2000**

programs which correspond to ordinary programs to be subsequently broadcasted and which are displayed as part of an electronic program guide (EPG). Takahashi does not disclose storing the incoming ordinary programs for later display. Small portions of the incoming broadcasted ordinary programs undergo an MPEG decoding process while being transmitted to the display. As disclosed by Takahashi at paragraph 0062 – 0063, “[t]he MPEG video decoder 33 stores the inputted picture data (digital picture data) to a memory 34 composed of a DRAM (dynamic random access memory) and others **as necessary to execute the MPEG decoding process ... These signals are supplied to the monitor 7 to be displayed**” (emphasis added).

Because Takahashi does not store the “ordinary program” for later display, the “promotion program” cannot be displayed to entice “the viewer to select for viewing the identified, previously locally stored premium content.” Thus, Takahashi does not teach “locally storing the identified premium content” and “displaying the selected promotion contents to entice the viewer to select for viewing the identified, previously locally stored premium content,” as recited by amended Claim 12. Therefore, Applicant submits that Takahashi does not disclose all the limitations of amended Claim 12, so amended Claim 12 is not anticipated by Takahashi. Applicant respectfully requests that the Examiner withdraw the rejection of amended Claim 12 and pass amended Claim 12 to allowance.

Claims 13-15, 16-18, and 20-23

Each of Claims 13-15, 17, and 23 depends from amended Claim 12, Claim 16 depends from Claim 15, each of Claims 18 and 20 depends from Claim 17, Claim 21 depends from Claim 20, and Claim 22 depends from Claim 21. Therefore, each of Claims 13-15, 16-18, and 20-23 includes all the limitations of amended Claim 12 as well as other limitations of particular utility. For at least the reasons stated above with respect to amended Claim 12, Applicant submits that Claims 13-15, 16-18, and 20-23 are patentably distinguished over Takahashi. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 13-15, 16-18, and 20-23 and pass these claims to allowance.

**Response to Rejection of Claims 1-4, 6, 10, 11, and 24-27 Under 35 U.S.C. § 103(a)**

In the October 20, 2005 Office Action, the Examiner rejects Claims 1-4, 6, 10, 11, and 24-27 under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of U.S. Patent Publication No. 2001/0029610 to Corvin et al. (“Corvin”).

Claim 1

Applicant has amended Claim 1 to recite (emphasis added):

1. A video system, comprising:
  - an input port configured to receive video data from a head end, the video data including a plurality of premium contents;
  - an output port configured to couple to a video display for displaying video data selected by a viewer;
  - a preference engine coupled to the input port and configured to track viewer selections of the video data and to create a viewer profile representing viewing preferences of the viewer;
  - a personal video recorder configured to locally store premium content from the plurality of premium contents;**
  - a local storage device; and
  - a promotion module coupled to the preference engine and the output port, the promotion module responsive to the viewer profile to select at least one preferred promotion content from the plurality of premium contents, to cause the selected at least one preferred promotion content to be stored on the local storage device, and **to cause the selected at least one preferred promotion content to be retrieved from the local storage device and displayed to entice the viewer to select for viewing previously locally stored premium content associated with the selected at least one preferred promotion content.**

**Claim limitations missing from both cited references**

Applicant submits that the combination of Takahashi in view of Corvin does not disclose or suggest all the claim limitations of amended Claim 1. For reasons similar to those discussed above with reference to amended Claim 12, Applicant submits that Takahashi does not disclose or suggest a system having a promotion module that causes “the selected at least one preferred promotion content to be retrieved from the local storage device and displayed to entice the viewer to select for viewing previously locally stored premium content associated with the selected at least one preferred promotion content,” as recited by Claim 1.

Applicant further submits that Corvin also does not disclose or suggest this limitation. Corvin discloses a system for providing promotions with recorded programs by recording selected promotions with the recorded programs or by inserting selected promotions during the playback of recorded programs (see, abstract of Corvin). While Corvin discloses that these promotions can include movie previews (see, e.g. Corvin at paragraph 0006), Applicant submits that Corvin does not disclose or suggest that the selected promotions correspond to previously

Appl. No. : 09/608,819  
Filed : June 30, 2000

locally stored programs. Therefore, display of the selected promotion during the playback of a recorded program does not serve to entice the viewer to select previously locally stored programs for viewing. Thus, Corvin does not disclose or suggest a promotion module which causes the selected preferred promotion content to be displayed “to entice the viewer to select for viewing previously locally stored premium content associated with the selected at least one preferred promotion,” as recited by amended Claim 1. Neither Takahashi nor Corvin discloses or suggests a promotion module which causes the selected preferred promotion content to be displayed “to entice the viewer to select for viewing previously locally stored premium content,” as recited by amended Claim 1, so the combination of Takahashi in view of Corvin does not disclose or suggest all of the claim limitations of amended Claim 1. As such, the combination of Takahashi and Corvin does not establish a *prima facie* case for obviousness because all of the claim limitations are not taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974); M.P.E.P. § 2143.03, pg. 2100-133 (Rev. 2, May 2004). Applicant therefore respectfully requests that the Examiner withdraw the rejection of Claim 1 and pass Claim 1 to allowance.

**No motivation to combine the cited references**

Applicant further submits that the Examiner has not presented a *prima facie* case of obviousness of Claim 1 because the prior art does not provide a motivation to combine Takahashi and Corvin.

The Examiner states that it would have been obvious to “modify the system of Takahashi by storing a program in a VCR located locally at or near a user’s television viewing equipment as taught by Corvin in order to allow the user to control playback of the stored program locally.” However, Applicant respectfully submits that the fact that Corvin discloses locally storing programs in a VCR does not provide a motivation to combine Takahashi with Corvin. The mere fact that the references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q. 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01, pg 2100-131 (Rev. 2, May 2004).

For the foregoing reasons, Applicant submits that amended Claim 1 is patentably distinguished over the cited prior art. Therefore, Applicant respectfully requests the Examiner to withdraw the rejection of Claim 1 and to pass Claim 1 to allowance.

**Appl. No.** : **09/608,819**  
**Filed** : **June 30, 2000**

Claims 2-4, 6, 10, 11, 24, and 25

Each of Claims 2, 3, 6, 10, 24, and 25 depends from amended Claim 1, Claim 4 depends from Claim 3, and Claim 11 depends from Claim 10. Therefore, each of Claims 2-4, 6, 10, 11, 24, and 25 includes all the limitations of amended Claim 1 as well as other limitations of particular utility. For at least the reasons stated above with respect to amended Claim 1, Applicant submits that Claims 2-4, 6, 10, 24, and 25 are patentably distinguished over Takahashi in view of Corvin. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 2-4, 6, 10, 11, 24, and 25 and pass these claims to allowance.

Claims 26 and 27

As discussed above, amended Claim 12 includes limitations which are not disclosed or suggested by Takahashi. Applicant submits that these limitations are also not disclosed by Corvin and that neither Takahashi nor Corvin provides a motivation to combine Takahashi and Corvin. Therefore, amended Claim 12 is patentably distinguished over the combination of Takahashi in view of Corvin.

Each of Claims 26 and 27 depends from amended Claim 12. Therefore, each of Claims 26 and 27 includes all the limitations of amended Claim 12 as well as other limitations of particular utility. For at least the reasons stated above with regard to amended Claim 12 being patentably distinguished over Takahashi in view of Corvin, Applicant submits that Claims 26 and 27 are patentably distinguished over Takahashi in view of Corvin. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 26 and 27 and pass these claims to allowance.

**Response to Rejection of Claims 7-9 Under 35 U.S.C. § 103(a)**

In the October 20, 2005 Office Action, the Examiner rejects Claims 7-9 under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Corvin and further in view of U.S. Patent No. 6,590,979 issued to Ryan ("Ryan").

As discussed above, amended Claim 1 includes limitations which are not disclosed or suggested by Takahashi in view of Corvin. Applicant submits that these limitations are also not disclosed by Ryan and that Ryan does not provide a motivation to combine Takahashi, Corvin, and Ryan. Therefore, amended Claim 1 is patentably distinguished over the combination of Takahashi in view of Corvin and further in view of Ryan.

**Appl. No.** : 09/608,819  
**Filed** : June 30, 2000

Claim 7 depends from amended Claim 1, Claim 8 depends from Claim 7, and Claim 9 depends from Claim 8. Therefore, each of Claims 7-9 includes all the limitations of amended Claim 1 as well as other limitations of particular utility. For at least the reasons stated above with regard to amended Claim 1 being patentably distinguished over Takahashi in view of Corvin and further in view of Ryan, Applicant submits that Claims 7-9 are patentably distinguished over Takahashi in view of Corvin and further in view of Ryan. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 26 and 27 and pass these claims to allowance.

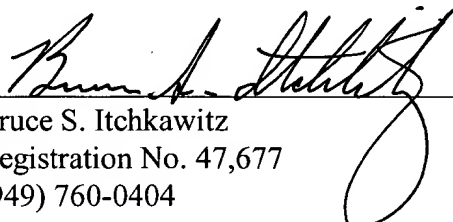
### **Summary**

For the reasons stated above, Applicant submits that Claims 1-4, 6-18, and 20-27 are in condition for allowance, and Applicant respectfully requests such action.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

Dated: 12/30/05

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